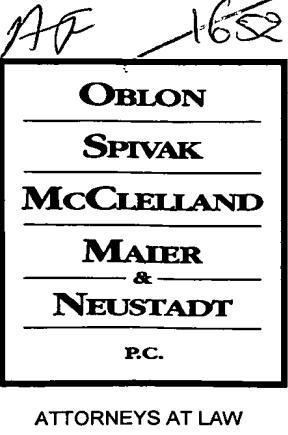




61

Docket No.: 0010-1075-0 PCT



COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/462,472

Applicants: Hiroshi MATSUI, et al.

Filing Date: January 14, 2000

For: METHOD FOR PRODUCING PURINE  
NUCLEOSIDE BY FERMENTATION

Group Art Unit: 1652

Examiner: Fronda, C.L.

SIR:

Attached hereto for filing are the following papers:

**Petition to the Commissioner Under 37 C.F.R. §1.144**

**Copy of Office Action dated June 21, 2001**

**Copy of Date-stamped Filing Receipt dated July 13, 2001**

**Copy of Response to Restriction and Election of Species Requirement filed July 13, 2001**

**Copy of International Preliminary Examination Report**

Our credit card payment form in the amount of \$130.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Stephen G. Baxter

Registration No. 32,884

Customer Number

22850

(703) 413-3000 (phone)  
(703) 413-2220 (fax)

Vincent K. Shier, Ph.D.  
Registration No. 50,552



Docket No.: 0010-1075-0 PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Hirochi MATSUI, et al.

: EXAMINER: FRONDA

SERIAL NO.: 09/462,472

: :

FILED: JANUARY 14, 2000

: GROUP ART UNIT: 1652

FOR: METHOD FOR PRODUCING PURINE NUCLEOSIDE BY FERMENTATION

PETITION TO THE COMMISSIONER UNDER 37 C.F.R. §1.144

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VA 22313-1450

SIR:

Petitioners respectfully petition the Commissioner to review and withdraw the Restriction Requirement of June 21, 2001. Petitioners also respectfully request that the Commissioner direct the Examiner to expand the scope of examination to include the non-elected members of the Markush group of Claim 13 in accordance with MPEP §803.02. The facts of this case are as follows.

A Restriction Requirement was mailed in this application on June 21, 2001 (a copy of which is **submitted herewith**), asserting that the application contains inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1 (paper number 7). On the basis of this assertion, the Office required restriction as follows<sup>1</sup>:

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130.00 DP

<sup>1</sup> Claims 6 and 7 were omitted from the Restriction Requirement, but have been withdrawn as reading on a non-elected invention.

Group I: Claim 1, drawn to a microorganism belonging to the genus *Escherichia* and having purine nucleoside-producing ability;

Group II: Claim 2, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because of an increase of an activity of an enzyme involved in purine nucleoside biosynthesis;

Group III: Claim 3, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because of an increase of an expression amount of a gene for an enzyme involved in purine nucleoside biosynthesis;

Group IV: Claims 4, 5, and 8, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because deregulation of control of an enzyme involved in purine nucleoside biosynthesis;

Group V: Claims 9 and 10, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because of a blockage of a reaction branching from purine nucleoside biosynthesis and leading to another metabolite;

Group VI: Claims 11 and 12, drawn to a microorganism belonging to the genus *Escherichia* which is enhanced in purine nucleoside-producing ability by weakening of incorporation of a purine nucleoside into cells of the microorganism; and

Group VII: Claim 13, drawn to a method for producing a purine nucleoside by fermentation comprising culturing a microorganism belonging to the genus *Escherichia*.<sup>2,3</sup>

In addition, the Examiner also required election of a single disclosed species of an enzyme from the following: succinyl-adenosine monophosphate synthase, purine nucleoside phosphorylase, adenosine deaminase, inosine-guanosine kinase, guanosine monophosphate reductase, 6-phosphogluconate dehydrase, phosphoglucose isomerase, adenine deaminase, and xanthosine phosphorylase.

A Response was timely filed on July 13, 2001 (a copy is submitted herewith),

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<sup>2</sup> Claims 14-26 were added in the Amendment and Request for Reconsideration filed on December 14, 2001 and read on the elected invention.

<sup>3</sup> Claim 27 was added in the Amendment and Request for Reconsideration filed on March 12, 2003 and read on the elected invention.

electing, with traverse, Group VII (Claim 13) and phosphoglucose isomerase as a single disclosed species (current Claims 1, 9, 10, and 13-22, 25, and 27 read on the elected species).

The Restriction Requirement was properly traversed on the grounds that examination on the merits of the entire application would not present a serious burden upon the Examiner and, as such, “the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” (MPEP §803) Moreover, Petitioners noted that evidence of the absence of a burden upon the Examiner is provided by the fact that the International Searching Authority had already examined all of the claims (including the species contained therein) together. Therefore, the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority (see the International Preliminary Examination Report **submitted herewith**). The Authority did not take the position that unity of invention was lacking in the International application and examined all claims together. Petitioners note that PCT Article 27(l) states:

No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

As such, the Office has failed to make out and/or apply a proper case for restriction.

Regarding the Election of Species Requirement, Petitioners offer the following:

Claim 13 provides a method for producing a purine nucleoside by fermentation comprising culturing a microorganism in a culture medium to produce and accumulate the purine nucleoside in the medium, and collecting the purine nucleoside, wherein the microorganism belongs to the genus *Escherichia* and has purine nucleoside-producing ability arising from inhibition of a reaction branching from purine nucleoside biosynthesis, and leading to another metabolite, in said microorganism, wherein said reaction is catalyzed by an enzyme selected from the group consisting of succinyl-adenosine monophosphate synthase,

purine nucleoside phosphorylase, adenosine deaminase, inosine-guanosine kinase, guanosine monophosphate reductase, 6-phosphogluconoate dehydrase, phosphoglucose isomerase, adenine deaminase, and xanthosine phosphorylase.

On June 21, 2001, the Examiner required an election of single disclosed species from the members of the Markush group above. In electing phosphoglucose isomerase, Petitioners directed the Examiner's attention to the fact that the Examiner's statement that the species lack unity of invention is incorrect (see Response to Restriction and Election of Species Requirement filed July 13, 2001). Specifically, Petitioners noted that

According to the PCT administrative instructions in MPEP, Annex B, Part I (f), the requirement of the same special technical feature as defined in PCT Rule 13.2 is considered to be met when the alternatives of a Markush group are of similar nature. Here, the enzymes have a common activity because they catalyze the reaction branching from the purine nucleoside biosynthesis. In addition, the compounds of the Markush group belong to a recognized class of chemical compounds in the art to which the invention pertains. All compounds are enzymes.

Despite the foregoing, the Examiner maintained the Election of Species Requirement for the members of the Markush group. Therefore, Petitioners reminded the Examiner that MPEP §803.02 *compels* examination of all the members of the Markush group in a situation like the present case. MPEP §803.02 states:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner **must** examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction. (*emphasis added*)

Despite the policies controlling examination of applications presenting species in a Markush group, the Examiner again, has maintained the Election of Species Requirement. In so doing, the Examiner notes: "the enzymes require separate searches that have different limits, boundaries, scope, and subject matter." (paper number 22, paragraph 2)

Petitioners submit that the Examiner has misapplied the examination standard provided by MPEP §803.02 for “PRACTICE RE MARKUSH-TYPE CLAIMS.” In the present application, Petitioners submit that the members of the Markush group are sufficiently few in number (only nine!!) so as not to constitute a serious burden upon the Examiner. Moreover, Petitioners submit that within the context of the present invention, the members of the Markush group are so closely related (i.e., facilitate production of a purine nucleoside by fermentation) so as not to constitute a serious burden upon the Examiner. Therefore, regardless of which standard under MPEP §803.02 is applied, for *each* of the reasons the Examiner ***must*** examine all the members in the Markush group in the claim on the merits.

Moreover, as stated in MPEP §803.02, “A Markush-type claim can include independent and distinct inventions... where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits.” In this scenario, two options are available to the Examiner: (1) “[i]f the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species” or (2) “[o]n the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim *will* be extended.” (*emphasis added; MPEP §803.02*)

As the record clearly bears out and as further evidenced by the Examiner’s indication that claims to the elected Species (phophoglucose isomerase) are allowable, Petitioners again note that the Examiner is ***compelled*** to expand the scope of the search to embrace the non-elected Species: succinyl-adenosine monophosphate synthase, purine nucleoside phosphorylase, adenosine deaminase, inosine-guanosine kinase, guanosine monophosphate

reductase, 6-phosphogluconoate deydrase, adenine deaminase, and xanthosine phosphorylase (Claim 13). Therefore, the Examiner's indication that the non-elected Species require "separate searches that have different limits, boundaries, scope, and subject matter" is of no relevance.

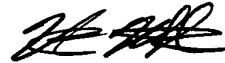
For the reasons stated above, the Examiner has made out a proper Restriction and Election of Species Requirement. Moreover, the Examiner has continued to disregard his compulsory obligations in the continuing refusal to broaden the scope of examination to include additional species present in the Markush grouping in Claim 13.

Accordingly, Petitioners respectfully petition the Commissioner to review and withdraw the Restriction Requirement of June 21, 2001. Petitioners also respectfully request that the Commissioner direct the Examiner to expand the scope of examination to include the non-elected members of the Markush group of Claim 13 in accordance with MPEP §803.02.

An early and favorable indication of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Stephen G. Baxter, Ph.D.  
Attorney of Record  
Registration No.: 32,884

Vincent K. Shier, Ph.D.  
Registration No.: 50,552

Customer Number

**22850**

PHONE: (703) 413-3000  
FAX: (703) 413-2220



## UNITED STATES DEPARTMENT OF COMMERCE

## United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/452,472	01/14/00	NATSUI	RE 0010-1075-6 PCT

MAR 22 2004

OIPE  
TRADEMARK OFFICE  
865  
OBLOON SPIVAK McCLELLAND  
MAIER & NEUSTADT  
1765 JEFFERSON DAVIS HIGHWAY  
FOURTH FLOOR  
ARLINGTON VA 22202

HM12/0621

EXAMINER

PRINDA, L.

ART UNIT	PAPER NUMBER
1652	

DATE MAILED:

05/21/01

RD 7-21-01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

RECEIVED  
JUN 25 2001  
OBLOON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
COPY

O  
MAR 22 2004  
SC98  
A  
Office Action Summary  
SEARCHED *✓* SERIALIZED *✓* FILED *✓*

<b>Office Action Summary</b> <small>EXAMINER'S OFFICE</small>	<b>Application No.</b> <b>09/462,472</b>	<b>Applicant(s)</b> <b>Matsui et al.</b>
	<b>Examiner</b> <b>Christian L. Fronda</b>	<b>Group Art Unit</b> <b>1652</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-13 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been  received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1652

**DETAILED ACTION*****Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

- I. Claim 1, drawn to a microorganism belonging to the genus *Escherichia* and having purine nucleoside-producing ability.
- II. Claim 2, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because of an increase of an activity of an enzyme involved in purine nucleoside biosynthesis
- III. Claim 3, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because of an increase of an expression amount of a gene for an enzyme involved in purine nucleoside biosynthesis
- IV. Claims 4, 5, and 8, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because of deregulation of control of an enzyme involved in purine nucleoside biosynthesis
- V. Claims 9 and 10, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because of blockage of a reaction branching from purine nucleoside biosynthesis and leading to another metabolite.
- VI. Claims 11 and 12, drawn to a microorganism belonging to the genus *Escherichia* which is enhanced in purine nucleoside-producing ability by weakening of incorporation of a purine nucleoside into cells of the microorganism.
- VII. Claim 13, drawn to a method for producing a purine nucleoside by fermentation comprising culturing a microorganism belonging to the genus *Escherichia*.

2. The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of Applicants' invention is the purine nucleoside producing ability of a microorganism belonging to the genus *Escherichia*. Neuhard et al. teach that *Escherichia coli* has a biosynthetic pathway to produce purine nucleosides (see pp. 445-473). Since Applicants' Inventions do not contribute a special technical feature when viewed over the

Art Unit: 1652

prior art, they do not have a single general inventive concept and therefore lack unity of invention.

3. Claims 6 and 7 are generic only to Group III or Group IV. If either Group III or Group IV is selected, then claims 6 and 7 will also be examined.

4. <sup>10</sup> Claim 9 is directed toward the following patentably distinct species of enzymes which are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: succinyl-adenosine monophosphate synthase, purine nucleoside phosphorylase, adenosine deaminase, inosine-guanosine kinase, guanosine monophosphate reductase, 6-phosphogluconate dehydratase, phosphoglucose isomerase, adenine deaminase, and xanthosine phosphorylase.]

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Each of these enzymes are independent chemical entities and require different literature searches that have different limits, scope, and subject matter.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

5. A telephone call was made to Kirstern A. Grueneberg on June 18, 2001, to request an oral election to the above restriction requirement, but did not result in an election being made.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Any inquiry concerning this communication or earlier communications from the examiner

Art Unit: 1652

should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. The fax phone number for this Group is (703)308-0294. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF



NASHAAT T. NASHED PH.D.  
PRIMARY EXAMINER



Docket No.: 0010-1075-0 PCT

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231



ATTORNEYS AT LAW

NORMAN F. OBLON  
(703) 413-3000  
NOBLON@OBLON.COM

Kirsten A. Grueneberg, Ph.D.  
Registered Patent Agent  
(703) 413-3000  
KGrueneberg@OBLON.COM

RE: Application Serial No.: 09/462,472  
Applicants: Hiroshi MATSUI, et al.  
Filing Date: January 14, 2000  
For: METHOD FOR PRODUCING PURINE  
NUCLEOSIDE BY FERMENTATION  
Group Art Unit: 1652  
Examiner: C. FRONDA

SIR:

Attached hereto for filing are the following papers:

**RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

*COPY*  
Norman F. Oblon  
Attorney of Record  
Registration No. 24,618



**22850**

Kirsten A. Grueneberg, Ph.D.  
Registration No. 47,297

(703) 413-3000 (phone)  
(703) 413-2220 (fax)



DOCKET NO.: 0010-1075-0 PCT

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

IN RE APPLICATION OF:

Hiroshi MATSUI, et al. : GROUP ART UNIT: 1652

SERIAL NO.: 09/462,472 : EXAMINER: C. FRONDA

FILED: January 14, 2000 :

FOR: METHOD FOR PRODUCING PURINE NUCLEOSIDE BY FERMENTATION

**RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT**

Responsive to the Official Action dated June 21, 2001, Applicants elect, with traverse, Group VII, Claim 13. In addition, Applicants elect with traverse, phosphoglucose isomerase as single disclosed species of an enzyme. Claims 1, 9, 10 and 13 read on the elected species.

**REMARKS**

The Office has required restriction in the present application as follows:

The Examiner has now indicated that the claims do not relate to a single general inventive concept and that they lack unity of invention. He is requiring an election of one of the following Groups:

Group I: Claims 1, drawn to a microorganism belonging to the genus *Escherichia* and having purine nucleoside-producing ability;

Group II: Claim 2, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because of an increase of an activity of an enzyme involved in purine nucleoside biosynthesis;

Group III: Claim 3, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because of an increase of an expression amount of a gene for an enzyme involved in purine nucleoside biosynthesis ;

Group IV: Claims 4, 5, and 8, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because of deregulation of control of an enzyme involved in purine nucleoside biosynthesis;

Group V: Claims 9 and 10, drawn to a microorganism belonging to the genus *Escherichia* which has acquired a purine nucleoside-producing ability because of blockage of a reaction branching from purine nucleoside biosynthesis and leading to another metabolite;

Group VI: Claims 11 and 12, drawn to a microorganism belonging to the genus *Escherichia* which is enhanced in purine nucleoside-producing ability by weakening of incorporation of a purine nucleoside into cells of the microorganism; and

Group VII: Claim 13, drawn to a method for producing a purine nucleoside by fermentation comprising culturing a microorganism belonging to the genus *Escherichia*.

In addition, the Examiner is also requiring election of a single disclosed species of an enzyme from the following: succinyl-adenosine, monophosphate synthase, purine nucleoside phosphorylase, adenosine deaminase, inosine-guanosine kinase, guanosine monophosphate reductase, 6-phosphogluconate dehydrase, phosphoglucose isomerase, adenine deaminase, and xanthosine phosphorylase.

Applicants elect, with traverse, Group VII, Claim 13. In addition, Applicants elect with traverse, phosphoglucose isomerase as single disclosed species of an enzyme. Claims 1, 9, 10 and 13 read on the elected species.

The Applicants respectfully traverse the Restriction Requirement on the following grounds. The MPEP in §803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together. Accordingly, the Restriction Requirement should be withdrawn.

Further, the Office, citing PCT Rules 13.1 and 13.2, contends that the species lack unity of invention because they are not so linked so as to form a single general inventive concept.

The Examiner's statement that the species lack unity of invention is incorrect. According to the PCT administrative instructions in MPEP, Annex B, Part I (f), the requirement of the same special technical feature as defined in PCT Rule 13.2 is considered to be met when the alternatives of a Markush group are of similar nature. Here, the enzymes have a common activity because they catalyze the reaction branching from the purine nucleoside biosynthesis. In addition, the compounds of the Markush group belong to a recognized class of chemical compounds in the art to which the invention pertains. All compounds are enzymes.

For the reasons set forth above, Applicants contend that the Election of Species Requirement is improper and should be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

**COPY**

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Norman F. Oblo  
Attorney of Record  
Registration No.: 24,618



**22850**

Kirsten A. Grueneberg, Ph.D.  
Registration No.: 47,297

PHONE NO.: (703) 413-3000  
FAX NO.: (703) 413-2220  
NFO:KAG:dbl

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O I P E  
MAR 22 2004

TRADEMARK OFFICE 8051

Dept.: CHEMICAL

By: NFO:KAG:dbl

OSMM&N File No. 0010-1075-0 PCT

Serial No. 09/462,472

In the matter of the Application of: Hiroshi MATSUI, et al.

For: METHOD FOR PRODUCING PURINE NUCLEOSIDE BY  
FERMENTATION

The following has been received in the U.S. Patent Office on the date stamped hereon:

<input type="checkbox"/> pp. Specification	Claims/Formal Drawings	Sheets
and pages Application Data Sheet		
<input type="checkbox"/> Combined Declaration, Petition & Power of Attorney		pages
<input type="checkbox"/> List of Inventor Names and Addresses		
<input type="checkbox"/> Utility Patent Application Transmittal		<input type="checkbox"/> CPA
<input type="checkbox"/> Notice of Priority		<input type="checkbox"/> Priority Doc
<input type="checkbox"/> Check for \$ -0-		<input checked="" type="checkbox"/> Dep. Acct. Order Form
<b>■ TRANSMITTAL LETTER TO THE USPTO</b>		
<input type="checkbox"/> Assignment/PTO 1595 pages:		
<input type="checkbox"/> Letter to Official Draftsman		
<input type="checkbox"/> Letter Requesting Approval of Drawing Changes		
<input type="checkbox"/> Formal Drawings	sheets	<input type="checkbox"/> Formal
<input type="checkbox"/> Letter		
<input type="checkbox"/> Amendment		
<input type="checkbox"/> Information Disclosure Statement		
<input type="checkbox"/> Cited References		
<input type="checkbox"/> Search Report		
<input type="checkbox"/> Statement of Relevancy		
<input type="checkbox"/> IDS/Related/List of Related Cases		
<b>■ RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT (1 Document)</b>		
<input type="checkbox"/> Petition for Extension of Time		
<input type="checkbox"/> Notice of Appeal		
<input type="checkbox"/> Brief		
<input type="checkbox"/> Issue Fee Transmittal		
<input type="checkbox"/> White Advance Serial Number Card		
<input type="checkbox"/> Small Entity Status is Claimed		
<input type="checkbox"/>		
<input type="checkbox"/>		

Due Date: JULY 21, 2001



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